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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/815,311	03/23/2001	Eduardo Grizante Redondo	05788.0157	7258

22852 7590 05/27/2003

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EXAMINER

GRAY, JILL M

ART UNIT

PAPER NUMBER

1774

DATE MAILED: 05/27/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

AS-13

Office Action Summary

Application No.

09/815,311

Applicant(s)

REDONDO ET AL.

Examiner

Jill M Gray

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 May 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 16-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 16-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

Applicants remarks regarding the claimed priority and rejection of claims 16-30 under 35 U.S.C. 102(b) over Sonada have been considered. Accordingly the finality of the last Office Action has been withdrawn and a new rejection follows.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 16-30 are rejected under 35 U.S.C. 102(e) as being anticipated by Sonoda et al, 5,707,732 (Sonoda), in view of Betso et al, 6,262,161 B1 (Betso) for reasons of record, wherein Betso is cited to show the state of the art:

Sonada teaches a flame retardant composition, cable coated with said composition and a method for producing said cable, wherein the cable comprises a conductor and a flame-retardant coating, said coating being essentially as claimed by applicants. This coating comprises (a) an ethylene copolymer having a density of from .905 to .970 g/cm³ and (b) a copolymer of ethylene with at least one alpha-olefin having a density of from 0.860 to 0.904 g/cm³, (c) magnesium hydroxide in an amount to impart flame-retardant properties, and grafting organo silane groups onto the polymer chain of

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at least one of the polymeric components. See column 2, lines 18-24, column 3, lines 53-57, and column 6, lines 41-59. Furthermore, Sonada teaches that the polymeric component (a) is a component of the type set forth in claim 17 (column 3, lines 64-67), and that the component (b) is made using a single-site catalyst as required by claim 19 (column 2, lines 30-31). Accordingly, the property required by claim 18 is inherent. As to claim 20, this is a process limitation drawn to the method of making the magnesium hydroxide that adds no patentable weight to the instant claimed cable. As to claims 21 and 22, Sonada teaches that the magnesium hydroxide is present within the range claimed by applicants in claim 22, which necessarily results in an LOI index as claimed in claim 21. See column 6, line 60 through column 7, lines 13. Regarding the hydrolzable organic silane groups grafted onto the polymer chain "for compatibilization of the natural magnesium hydroxide with the polymeric components", organo silane compounds are known coupling agents. Hence, this requirement is not more than the requirement that the organic silane component function in its normal capacity, i.e. the function as a coupling agent. Betso is cited to show the state of the art at the time the invention was made, and teaches compositions comprising an ethylene random interpolymers, magnesium hydroxide and silane coupling agents. The coupling agent can be grafted onto the interpolymers and serves to couple the filler to the interpolymers. Thus this property is an inherent function of the organic silane component.

Response to Arguments

3. Applicant's arguments filed May 13, 2003 have been fully considered but they are not persuasive.

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Applicants argue that Sonoda teaches synthetic magnesium hydroxide whereas the present invention requires natural magnesium hydroxide, which is not identical to synthetic magnesium hydroxide. In this regard, Sonoda uses his magnesium to obtain the same properties and purpose as does applicants, namely, to impart flame-retardant properties. Furthermore, there is no clear factual evidence on this record of unexpected or superior properties of a self-extinguishing cable having a flame-retardant coating composition, when the flame-retardant used is natural magnesium hydroxide instead of synthetic magnesium hydroxide, said unexpected or superior properties being directly related to the claimed critical natural magnesium hydroxide. Accordingly, it is the examiner's position, in the absence of such evidence, that this requirement is not a matter of invention.

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jill M Gray whose telephone number is 703.308.2381. The examiner can normally be reached on 10:00-7:00.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on 703.308.0449. The fax phone numbers for the organization where this application or proceeding is assigned are 703.305.5408 for regular communications and 703.305.3599 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703.308.0651.



Jill M Gray
Examiner
Art Unit 1774

jmg
May 22, 2003